

Appl. No. 09/675,113
Amtd. Dated July 2, 2004
Reply to Office action of April 5, 2004

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed April 5, 2004. In the Office Action, claims 1,2 4-24 and 26-33 were rejected under 35 U.S.C. §102(e) as being anticipated by Wiedemer (U.S. Patent No. 4,796,181). Applicants respectfully traverse the rejection the rejection because a *prima facie* case of anticipation has not been established.

In general, as previously described in the prior amendment, the subject application defines "relocation" as a process by which addresses within each BIOS module are adjusted based on the particular address location in memory allotted for the BIOS module. Therefore, if relocation is performed on an execute-in-place BIOS module, digital signatures are ineffective because the BIOS module would be modified after the digital signature is formed.

As the Examiner is aware, a *prima facie* case of anticipation requires that each and every limitation of the claimed invention be disclosed, either explicitly or inherently, in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). With respect to independent claims 1 and 24, Applicants respectfully submit that Wiedemer does not disclose the storage of a *post-relocation* image, namely an image after *relocation* of the *pre-relocation* image, *relocation information* and a *digital signature based on the pre-relocation image*. *Emphasis added*. Instead, Wiedemer discloses an application program and an enciphered application program, which are alleged to teach the *pre-relocation* image and the *post-relocation* image, respectively. However, this interpretation is inaccurate because enciphering of an application program, considered to be the *pre-relocation* image, does not produce a "*post-relocation* image" as described in the specification and further explained above.

Applicants respectfully request the Examiner to withdraw the §102(e) rejection pertaining to independent claims 1 and 24 as well as those claims dependent thereon.

With respect to claims 13 and 31, Applicants respectfully submit that Wiedemer does not disclose software modules or the operations of (1) *reconverting a post-relocation image of a digitally signed image back to a pre-relocation image*, the *pre-relocation* image being an image of a software module prior to relocation where an address with the digitally signed image is changed, or (2) conducting a hash operation on the *reconverted*, *pre-relocation* image to produce a *reconverted* hash value. *Emphasis added*. Decipher of the enciphered application program does not constitute *reconverting* the *post-relocation* image (i.e., resulting data after relocation performed on the *pre-relocation* image) into the *pre-relocation* image as claimed.

As a result, Applicants respectfully request the Examiner to withdraw the §102(e) rejection pertaining to independent claims 13 and 31 as well as those claims dependent thereon.

In accordance with *In re Morris*, 44 U.S.P.Q.2d 1023, 1027-1028 (Fed. Cir. 1997), the "PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in the applicant's specification." *Emphasis added*.

Appl. No. 09/675,113
Amtd. Dated July 2, 2004
Reply to Office action of April 5, 2004

See also MPEP § 2111. Herein, the general association of pre-relocation & post-relocation images to application programs and enciphered application programs is unreasonable, warranting reconsideration and withdrawal of the §102(e) rejection.

Appl. No. 09/675,113
Amdt. Dated July 2, 2004
Reply to Office action of April 5, 2004

Conclusion

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 7/2/2004

By

William W. Schaal

Reg. No. 39,018

Tel.: (714) 557-3800 (Pacific Coast)

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.84)

I hereby certify that this correspondence is, on the date shown below, being:
MAILING **FACSIMILE**

deposited with the United States Postal Service
as first class mail in an envelope addressed to:
Commissioner for Patents, PO Box 1450,
Alexandria, VA 22313-1450.

transmitted by facsimile to the Patent and
Trademark Office.

Date: 7/2/2004

Susan McFarlane

7/2/2004

Date